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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,363	11/22/2000	Jari Suutarinen	796.377USW1	6589

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EXAMINER

LEE, JOHN J

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,363

Applicant(s)

SUUTARINEN, JARI

Examiner

JOHN J LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The Applicant's arguments/amendment received on March 05, 2004 have been carefully considered but they are not persuasive because the teaching of the cited reference as set forth in the previous rejection reads on the claimed limitation as claims 12, 13, and 15.

Also, Applicant's arguments with respect to claims 1 – 11, 14, and 16 have been considered but are moot in view of the new ground(s) of rejection.

Therefore, the finality of this Office Action is deemed proper.

Re Claim 12: The Examiner respectfully disagrees with Applicant's assertion that the Foti (US Patent number 5,974,309) does not teach each and every element of independent claim 12. Contrary to Applicant's assertion, the teaching of the reference (Foti) reads on all claimed limitation in claim 12 as see the action below:

Foti discloses that a mobile communications system (Fig. 1 and column 1, lines 9 – 11). Foti teaches that at least one mobile station (14 in Fig. 1). Foti teaches that a communications network with which said at least one mobile station (14 in Fig. 1) is arranged to communicate (Fig. 1 and column 2, lines 51 – column 3, lines 32, where teaches identifying the switching node that currently serves the called mobile station subscriber). Foti teaches that tracing facility for tracing at least one of said mobile stations (column 3, lines 9 – 44, abstract, and Fig. 1, law enforcement tracing center monitors a mobile station). Foti teaches that the tracing facility (28 in Fig. 1) has a predefined trace activation number (particular directory number of called party (calling line identification)) for activating tracing of said at least one mobile station in response to a communication from said at least one mobile station to the trace activation number (when mobile station calls predefined directory number of particular party or called party, enforcement tracing center automatically activates the tracing of the call by setting up, see Fig. 3, abstract, and column 5, lines 60 – column 6, lines 29).

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The claim is not require or limit the tracing for the mobile station is enabling monitoring of network performance. Also, the claimed limitation is not requiring that predefined tracing activation number is specific and particular number.

Applicant's attention is directed to the rejection below for the reasons as to why the claimed limitation is not patentable.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. **Claims 12, 13, and 15** are rejected under 35 U.S.C. 102(e) as being anticipated by Foti (US Patent number 5, 974,309).

Regarding **claim 12**, Foti discloses that a mobile communications system (Fig. 1 and column 1, lines 9 – 11). Foti teaches that at least one mobile station (14 in Fig. 1).

Foti teaches that a communications network with which said at least one mobile station (14 in Fig. 1) is arranged to communicate (Fig. 1 and column 2, lines 51 – column 3, lines 32, where teaches identifying the switching node that currently serves the called mobile station subscriber). Foti teaches that tracing facility for tracing at least one of said mobile stations (column 3, lines 9 – 44, abstract, and Fig. 1, law enforcement tracing center monitors a mobile station). Foti teaches that the tracing facility (28 in Fig. 1) has a predefined trace activation number (particular directory number of called party (calling line identification)) for activating tracing of said at least one mobile station in response to a communication from said at least one mobile station to the trace activation number (when mobile station calls predefined directory number of particular party or called party, enforcement tracing center automatically activates the tracing of the call by setting up, see Fig. 3, abstract, and column 5, lines 60 – column 6, lines 29).

Regarding **claim 13**, Foti discloses all the limitation, as discussed in claim 12.

Regarding **claim 15**, Foti discloses the recording mechanism for recording all information available to a network concerning a call path, including internal messages of the network (Fig. 3, abstract, and column 5, lines 60 – column 6, lines 29).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 1 – 11, 14, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Foti (US Patent number 5, 974,309) in view of Sanmugam (US Patent number 5,978,669).

Regarding **claims 1 and 16**, Foti discloses that a method of trace activation in a communications system, wherein a mobile station (14 in Fig. 1) is in communication with a mobile communications network (Fig. 1, 3 and column 2, lines 51 – column 3, lines 57). Foti teaches that directing a communication from the mobile station (14 in Fig. 1) to a predefined trace activation number (particular directory number of called party (calling line identification)) of tracing facility (12 in Fig. 1) (when mobile station calls predefined directory number of particular party or called party, enforcement tracing center automatically activates the tracing of the call by setting up, see Fig. 3, abstract, and column 5, lines 60 – column 6, lines 29). Foti teaches that activating tracing at the tracing facility (12 in Fig. 1) for the mobile station from which the communication originates (column 3, lines 9 – 44, Fig. 1, and column 5, lines 60 – column 6, lines 29, where teaches assuming that a cellular call originates with a calling party A and dialed to the directory telephone number (B party-number) of the called mobile station, and home database is queried with the dialed B-number to determine called subscriber location, and then activates tracing/monitoring the call). Foti also teaches that generating a trace report (print (32) in Fig.1) for the mobile station (Fig. 2 and column 3, lines 58 – column 4, lines 30).

Foti does not specifically disclose the limitation “directing a communication from the mobile station to a predefined tracing class of tracing facility for activation tracing of the mobile station”. However, Sanmugam discloses the limitation “directing a communication from the mobile station to a predefined tracing class of tracing facility for activation tracing of the mobile station” (Fig. 2, 14 and column 26, lines 9 – column 27, lines 19, where teaches mobile station tracing class is activated, the servicing exchange will continuously report to the home system along with information for activating tracing mobile station). It would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify Foti system as taught by Sanmugam, provide the motivations to achieve providing an efficient mobile tracing service in mobile communication system.

Regarding **claim 2**, Foti and Sanmugam disclose all the limitation, as discussed in claim 1. Furthermore, Foti further discloses that deactivating tracing when the call is ended (Fig. 2 and column 4, lines 52 – 65 where teaches law enforcement agency monitors the voice communication and network data for the call, regarding the deactivating monitoring as call is ended).

Regarding **claim 3**, Foti discloses that the directed communication is a message (particular directory number of called party) from the mobile station (column 3, lines 9 – 44, abstract, and Fig. 1, where teaches directed communicating between mobile station and switching node).

Regarding **claim 4**, Foti does not specifically disclose the limitation “deactivating tracing when a preset time period is elapsed”. However, Sanmugam discloses the

limitation “deactivating tracing when a preset time period is elapsed” (Fig. 13, 14 and column 25, lines 59 – column 26, lines 33, where teaches the activity reporting is terminated when the tracing is deactivated by the expiration of a tracing timer). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Foti system as taught by Sanmugam. The motivations do so would be to improve efficient call tracing control in mobile communication system.

Regarding **claim 5**, Foti discloses that deactivating tracing when a second message from the mobile station is directed to the predefined trace activation number (column 3, lines 9 – 44, abstract, and Fig. 1).

Regarding **claim 6**, Foti and Sanmugam disclose all the limitation, as discussed in claim 1.

Regarding **claim 7**, Foti and Sanmugam disclose all the limitation, as discussed in claims 1 and 2.

Regarding **claim 8**, Foti discloses that the communication is forwarded to the predefined trace activation number (column 3, lines 9 – 44, abstract, and Fig. 1 where teaches home database is queried the directory number to determine whether monitor or not, and if the number is identified, forwards the call to monitoring center).

Regarding **claim 9**, Foti discloses that tracing is activated and deactivated automatically at the switching center (column 3, lines 9 – 44, abstract, and Fig. 1 where teaches home database in switching network is queried the directory number to determine whether monitor or not, tracing activation or not).

Regarding **claim 10**, Foti and Sanmugam disclose all the limitation, as discussed in claim 1.

Regarding **claim 11**, Foti discloses that equipment (recorded for future use by tape recorder) tracing is activated for the mobile station (column 4, lines 31 – 65 and Fig. 2).

Regarding **claim 14**, Foti discloses that recording all information available to a network concerning a call path (calling line identification), including internal messages (call information) of the network (column 4, lines 31 – 65 and Fig. 2).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Arinell (US Patent number 5,694,451) discloses An Arrangement for Performance Monitoring in a Telecommunications Network.

Osborne (US Patent number 6,088,588) discloses Method and Wireless Terminal for Monitoring Communications and Providing Network with Terminal Operation Information.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6606 (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

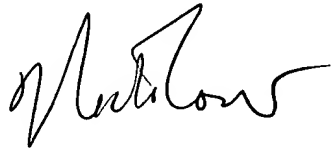
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(703) 306-5936**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Nay**

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Aung Maung, can be reached on (703) 308-7745. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L.
May 16, 2004



John J Lee

**NICK CORSARO
PATENT EXAMINER**